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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,269	09/28/2000	Jian J. Chen	LAMIP151	6726

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EXAMINER

ALEJANDRO MULERO, LUZ L

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/676,269

Applicant(s)

CHEN ET AL.

Examiner

Luz L. Alejandro

Art Unit

1763

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-10, 12, 13 and 15-26.

Claim(s) withdrawn from consideration: 14.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
Luz L. Alejandro  
Primary Examiner  
Art Unit: 1763

Continuation of 2. NOTE: incorporating dependent claim 25 into independent claim 23 raises new issues requiring further consideration and/or search because the limitations of dependent claim 24 (in its newly amended form) were never considered previously (the limitations of old claims 23-25 were never considered in one claim).

Continuation of 5. does NOT place the application in condition for allowance because: in response to applicant's statement concerning the final rejection to be improper, the examiner respectfully contends that there was never a claim in the instant application that combined former claims 1, 7, 9 and 11 in a single claim. Therefore, the final rejection was a new ground of rejection and the final rejection is proper. With respect to the rejection under 35 USC 103(a) of Imafuku et al. and Aruga et al., the examiner respectfully contends that all the limitations are taught and the motivation to combine references is proper. Concerning applicant's statement that Imafuku et al. fails to show an exposed insulating surface, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).. Furthermore, Aruga et al. provides ample motivation to cover a conductor with an insulator in a plasma environment. Aruga et al. is being used for the broad teaching of covering a conductor with an insulator for protection in a plasma environment, not any other specific apparatus limitations. Regarding the conductive guide being grounded in Imafuku et al., it is clear from the disclosure that this is an embodiment which was envisaged by the inventors at the time of filing (see col. 11-lines 58-67). It appears that applicants are attempting to say that the Aruga et al. is non-enabled for this particular feature. In response to this argument, the examiner contends that U.S. Patents are presumed valid (35 USC 282) and absent any persuasive secondary evidence to show non-enablement, this rejection will also be maintained. Concerning applicant's contention that the first and second confining elements which are rings that surround first and second electrodes is not shown, this has also not been shown to be persuasive. For example, the first confining element 27 in Imafuku et al. clearly surrounds upper electrode 21 and the second confining element 47 clearly surrounds a second electrode defined either by the electrostatic chuck or the upper surface of the susceptor electrode 5. Concerning applicant's other statements under 35 USC 103(a) it is respectfully submitted that Imafuku does not teach away from the instant invention. For example, the reference clearly teaches plasma confinement in a variety of areas (see col. 10-line 19 to col. 11-line 67). With respect to applicant's technical arguments, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). Concerning applicant's statement that the specification of the instant application is being used as a blueprint to formulate a rejection, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 44 F.2d 1392, 170 USPQ 209 (CCPA 1971).